

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Radu

Appeal No. _____

Appellants: Bogdan Radu et al.
Serial Number: 10/711,480
Filed: September 21, 2004
Art Unit: 3612
Examiner: Bao Q. Truong
Title: AUTOMOTIVE STORAGE COMPARTMENT HAVING AN
ELECTROLUMINESCENT LAMP AND METHOD OF MAKING
THE SAME
Confirmation No.: 5479
Atty. Docket No.: MASL-55

Cincinnati, Ohio 45202

April 5, 2007

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BRIEF ON APPEAL

This brief is in furtherance of Appellants' Notice of Appeal filed January 19, 2007, appealing the decision of the Examiner dated November 8, 2006, finally rejecting claims 1-8. A copy of the claims appears in the Appendix to this brief.

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I. Real Party in Interest

The real party in interest is International Automotive Components Group, LLC, of New York, New York, which is the assignee of the present invention.

II. Related Appeals and Interferences

There are no related appeals or interferences known to Appellants or Appellants' legal representative that will directly affect or be directly affected by the decision of the Board in the present appeal.

III. Status of the Claims

Claims 1-8 are pending in the Appellants' application. Claims 1-4 and 6-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,315,436 to Schenk et al. ("Schenk") in view of U.S. Patent No. 6,464,381 to Anderson, Jr. et al. ("Anderson"). Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Schenk in view of Anderson and further in view of U.S. Patent No. 5,158,353 to Kimisawa. All of the pending claims are the subject of this appeal.

IV. Status of Amendments

There have been no amendments filed after the rejection mailed on November 8, 2006.

V. Summary of Claimed Subject Matter

Referring to FIGS. 1 and 2 for the sake of exemplary illustration, Appellants' claim 1 is directed generally to an automotive interior trim assembly, such as door panel (10) for a door of an automobile, having a storage compartment (12) within a support (14) of the door panel (10). (Application at page 6, lines 13-16). The storage compartment (12) is coupled to the support (14) of the door panel (10) and is adapted to store one or more items. (Application at FIG. 1 and page 7, lines 18-19). The storage compartment (12) includes a compartment body (20) defining a cavity (22) to store the one or more items as well as an opening (24) for gaining access to the cavity (22). (Application at FIG. 2 and page 7, lines 16-19). The storage compartment (12) also includes a cover (30) coupled to the compartment body (20) and which is moveable between an open position and a closed position. (Application at FIGS. 1-2, page 8, lines 4-5 and 22-23, and page 9, lines 1-4). The storage compartment (12) includes an electroluminescent lamp (34) molded to either the compartment body (20) or the cover (30) and which is adapted to illuminate the cavity (22) when the cover (30) is in the open position. (Application at FIGS. 1-2, page 9, lines 8-13, page 12, lines 4-7, and page 13, lines 13-15).

Appellant's claim 8 is directed generally to an automotive interior trim assembly, such as door panel (10) for a door of an automobile, having a storage compartment (12) within a support (14) of the door panel (10). (Application at page 6, lines 13-16). The storage compartment (12) is coupled to the support (14) of the door panel (10) and is adapted to store one or more items. (Application at FIG. 1 and page 7, lines 18-19). The storage compartment (12) includes a compartment body (20)

defining a cavity (22) to store the one or more items as well as an opening (24) for gaining access to the cavity (22). (Application at FIG. 2 and page 7, lines 16-19). The compartment body (20) includes a first connecting member (26) integrally formed therein (Application at FIG. 2 and page 7, lines 19-24 through page 8, line 1). The storage compartment (12) also includes a cover (30) moveable between an open position and a closed position. (Application at FIGS. 1-2, page 8, lines 4-5, and page 9, lines 1-4). The cover (30) includes a second connecting member (32) integrally formed therein (Application at FIG. 2 and page 8, lines 4-6) and such that the first and second connecting members (26, 32) cooperate to couple the cover (30) to the compartment body (20). (Application at FIG. 2 and page 8, lines 20-23). The storage compartment (12) includes an electroluminescent lamp (34) coupled to either the compartment body (20) or the cover (30) and which is adapted to illuminate the cavity (22) when the cover (30) is in the open position. (Application at FIG. 2, page 9, lines 8-13, and page 12, lines 4-7).

VI. Grounds of Rejection to be Reviewed on Appeal

1. Whether claims 1-4 and 6-8 were improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,315,436 to Schenk et al. in view of U.S. Patent No. 6,464,381 to Anderson, Jr. et al.

VII. Argument

A. Overview

The claims presently stand rejected for obviousness under 35 U.S.C. §103(a). For present purposes, the arguments of this brief focus on independent claims 1 and 8, for if the rejections thereof fall, the rejections of the dependent claims, particularly claims 2-7, must necessarily fall. *See, e.g., Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987) (dependent claims not obvious if independent claims not obvious over the art). Appellants do not, however, waive the right to present arguments directed specifically to the dependent claims referred above, should that become necessary.

B. Claims 1-4, and 6-8 were improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over Schenk et al. in view of Anderson, Jr., et al.

Claims 1-4 and 6-8 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,315,436 to Schenk et al. ("Schenk") in view of U.S. Patent No. 6,464,381 to Anderson, Jr. et al. ("Anderson"). Claims 1 and 8 are the only independent claims of this rejected group.

Claim 1 is directed to an automotive interior trim assembly comprising:

a support; and

a storage compartment coupled to said support and adapted to store one or more items, said storage compartment comprising:

a compartment body defining a cavity adapted to store the one or more items and having an opening for gaining access to said cavity; and

a cover coupled to said compartment body and moveable between an open position, wherein said cavity is accessible through said opening, and a closed position, wherein said cover overlies said opening; and

an electroluminescent lamp molded to one of said compartment body and said cover and adapted to illuminate said cavity when said cover is in the open position.

Claim 8 is directed to an automotive interior trim assembly comprising:

a support; and

a storage compartment coupled to said support and adapted to store one or more items, said storage compartment comprising:

a compartment body defining a cavity adapted to store the one or more items and having an opening for gaining access to said cavity, said compartment body including a first connecting member integrally formed therein; and

a cover including a second connecting member integrally formed therein, said first connecting member cooperating with said second connecting member to couple said cover to said compartment body, said cover being moveable between an open position, wherein said cavity is accessible through said opening, and a closed position, wherein said cover overlies said opening; and

an electroluminescent lamp coupled to one of said compartment body and said cover and adapted to illuminate said cavity when said cover is in the open position.

1. Schenk fails to teach or suggest a molded lamp in a compartment body as asserted by the Examiner in the Office Action.

The rejection of claim 1 should be reversed because the Examiner failed to present a *prima facie* case of obviousness. In particular, Schenk fails to teach or suggest the elements of claim 1 as asserted by the Examiner in the Final office Action mailed November 8, 2006. More specifically, the Examiner relies on Schenk for the

teaching of a lamp molded in a compartment body. Schenk, however provides no such teaching or suggestion.

The Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to an applicant to come forward with the evidence or an argument. *Id.* If the examination at the initial stage does not produce a *prima facie* case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the plain subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 782 (Fed. Cir. 1993). In other words, to properly combine references to make a *prima facie* case of obviousness, there must have been some teaching or suggestion in either one of the references or both, or knowledge generally available to one of ordinary skill in the relevant art that would have led one skilled in the art to combine the relevant teachings of the references. *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983).

In particular, the Examiner's rejection of claim 1 should be reversed because he fails to specifically and clearly point out where and how Schenk discloses a "lamp [18] molded to the compartment body [11]" as suggested in the Office Action (Final Office Action mailed November 8, 2006 at page 5). The Examiner's presentation of a *prima facie* case of obviousness is limited to the citation of "figure 1" as the source for his assertion that Schenk teaches a "lamp [18] molded to the compartment body [11]."

In fact, the lamp [18] of Schenk is only generally shown in figure 1 thereof. (Schenk, FIG. 1). Moreover, the detailed description of Schenk provides further confirmation of this fact by stating that "FIG. 1 only shows a transparent covering 19." (Schenk, column 3, lines 1-2). Thus, while the Examiner asserts that Schenk teaches a "lamp molded to the compartment body," Schenk only shows a transparent covering. In light of this fact, there is nothing in figure 1 or in any other part of the disclosure of Schenk that teaches or suggests "a lamp [18] molded to the compartment body [11]" as asserted in the Office Action. (Final Office Action mailed November 8, 2006 at page 5).

(a) The Examiner impermissibly ignores the express language of claim 1.

The rejection of claim 1 should be reversed because the Examiner fails to give proper weight to all terms recited therein. In the Final Office Action mailed on November 8, 2006, and previously, in the Office Action mailed on June 23, 2006, the Examiner appears to give no weight or pay any attention to the term "molded" as recited in claim 1.

The positive recitation of all features in the claim requires that the Examiner properly construe and consider all terms rather than dismiss them as he seeks to do here. Each element in a claim is deemed material to defining the scope of the invention and cannot be effectively ignored. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 117 S. Ct. 1040, 41 USPQ2d 1865, 1871 (1997); *See also Lemelson v. United States*, 752 F.2d 1538, 1551, 224 USPQ 2d 524, 533 (Fed. Cir. 1987) (it is well

settled that each element of a claim is material and essential). Thus, the law requires an Examiner to consider all claim elements. Failure to do so is error that undermines the rejection.

In the two office actions referred to above, the Examiner seems to ignore the recited term “molded” of claim 1. For example, and as described above, the Examiner states that Schenk “discloses the lamp [18] molded to the compartment body [11] (see figure 1).” (Final Office Action mailed November 8, 2006 at page 5). Even if it is assumed, for the sake of argument, that Schenk discloses more than only a lamp covering. Schenk certainly does not teach a lamp [18] that is “molded” to the compartment body [11]. In other words, one of ordinary skill in the art would not conclude that the lamp [18] shown in figure 1 of Schenk is “molded” to the compartment body [11]. That is apparently a conclusion drawn by the Examiner through either error or unsupported assumption.

The Examiner fails, as discussed above, to properly consider all terms recited in claim 1. Accordingly, the Examiner fails to present a *prima facie* case of obviousness rendering his rejection of claim 1 improper. Accordingly, Appellants respectfully request that the rejection be overturned. Moreover, as claims 2-7 depend from allowable independent claim 1, the rejection of these claims should be overturned as well.

2. The Examiner uses impermissible hindsight when seeking to combine the teachings of Schenk with those of Anderson to arrive at the invention of claim 1.

The rejection of claim 1 should be reversed because the Examiner failed to provide at least an implicit motivation to combine the teachings of Schenk with those of Anderson to arrive at the invention recited in claim 1.

When there is no express teaching to combine two or more references, examiners can look for evidence of motivation in “the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem.” *Promold & Tool Co. v. Great Lakes Plastics, Inc.*, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

Anderson is directed to a vehicle interior component assembly such as headliner [10] that uses one or more electroluminescent panels [12] to provide interior illumination (Anderson at par. 3, lines 51-67). The invention disclosed in Anderson seeks to:

provide a vehicle interior lighting system that can be used to provide area or feature lighting in a manner that minimizes the aesthetic impact of the light source when not in use and that requires negligible space behind the interior body panel or trim component where the light source is located.

(Anderson at par. 2, lines 5-10).

Thus, the problem Anderson seeks to solve is related to the aesthetic problems of prior art light sources when such light sources are not in use, as well as problems related to the space requirements associated with such devices. This is

further corroborated by the Examiner's own assertion when he states, in pertinent part that

[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the shining lamp of Schenk et al. with the electroluminescent lamp as taught by Anderson, Jr. et al. for purpose of minimizing an aesthetic impact of a light source when not in use and that requires negligible space behind an interior trim assembly where the light source is located.

(Final Office Action mailed November 8, 2006 at page 3)

In contrast, the invention of claim 1 seeks to solve a different set of problems, as noted below:

The EL lamp 34 has a low power consumption and a very low heat generation as compared with conventional lamps used in such automotive applications. Furthermore, the EL lamp 34 is sturdy and exhibits excellent vibration and impact resistance. The EL lamp 34 will have a lengthy life and, as a result, will not normally need replacement over the life of the automobile, in contrast to the need to periodically replace burnt-out conventional incandescent bulbs. Moreover the resin materials used to form compartment body 20 and/or cover 30 need not be heat resistant as the EL lamp 34 has a cooler operating temperature than conventional incandescent bulbs.

(Application at page 12, lines 22-24 and page 13, lines 1-8).

Another pertinent section of the Application asserts yet another problem that the invention of claim 1 seeks to solve:

Thus, under current manufacturing processes, storage compartments having a lighting system provided therewith comprise numerous parts

each having different part numbers that must all be appropriately supplied, tracked, shipped, inventoried and eventually assembled to make the complete product. Multiple part assemblies in turn lead to significant administrative costs and labor costs, which increase the overall costs of production.

(Application at page 3, lines 15-21).

From the above, it is clearly ascertainable that the sets of problems sought to be solved by the invention of claim 1 and that in Anderson, are different. The motivations that led to the respective inventions of Anderson and that recited in claim 1 are expressly different. The Examiner, therefore uses impermissible hindsight when imputing the advantages recited in Anderson to those provided by the invention recited in claim 1 to thereby attempt to combine the Schenk and Anderson references and thus arrive at the invention of claim 1.

Since the Examiner uses impermissible hindsight in attempting to combine the teachings of Schenk to those of Anderson, his rejection of claim 1 is improper. Accordingly, Appellants respectfully request that the rejection be overturned. Moreover, as claims 2-7 depend from allowable independent claim 1 the rejection of these claims should be overturned as well.

3. The Examiner failed to consider the express language of claim 8.

The rejection of claim 1 should be reversed because the Examiner failed to present a *prima facie* case of obviousness. In particular, the rejection of claim 8 should be reversed because the Examiner fails to consider all terms recited therein.

**(a) The Examiner impermissibly ignores the term “including”
as recited in claim 8.**

In the Final Office Action mailed on November 8, 2006, and previously, in the Office Action mailed on June 23, 2006, the Examiner appears to give no weight to or chooses to simply dismiss the express language, in claim 8, related to the compartment body [20] and cover [30]. More specifically, the Examiner ignores the language providing a compartment body [20] and cover [30] respectively including first and second connecting members [26, 32] and further wherein such connecting members [26, 32] are integrally formed, respectively, with the compartment body [20] and cover [30], as recited in claim 8.

The positive recitation of all features in the claim requires that the Examiner properly construe and consider all terms rather than dismiss them as he seeks to do here. Each element in a claim is deemed material to defining the scope of the invention and cannot be effectively ignored. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 117 S. Ct. 1040, 41 USPQ2d 1865, 1871 (1997); *See also Lemelson v. United States*, 752 F.2d 1538, 1551, 224 USPQ 2d 524, 533 (Fed. Cir. 1987) (it is well settled that each element of a claim is material and essential). Thus, the Examiner was required (and is always required) to consider all positive limitations recited in a claim. Failure to do so is error that undermines the rejection.

The Examiner seems to ignore the positively recited term “including” in reference to parts defining the compartment body [20] and cover [30]. For example, in the Final Office Action, the Examiner limits his rejection to the statement: “[h]owever, Schenk discloses [sic] two pivot bearings [17] to couple the cover to the compartment

body (figure 1, column 2 lines 60-65).” (Final Office Action mailed November 8, 2006 at page 5). Rather than specifying how each of the alleged first and second connecting members [17] of Schenk are exclusively and respectively included in the compartment body [11] and cover [16], the Examiner simply states that he “believes in a car, there are a first connecting member integrally formed in a compartment body and a second connecting member integrally formed in a cover, as a locking system, to open/close/retain the cover in closed position with the compartment body.” (Final Office Action mailed November 8, 2006 at page 5).

In other words, the Examiner ignores the term “including” with reference to the compartment body [11] and cover [16] of Schenk respectively including first and second connecting members [17]. More particularly, the Examiner fails to meet his burden to demonstrate how each of his alleged connecting members [17] is respectively a part of the compartment body [11] and cover [16].

Moreover, the Examiner provides an unreasonable alternative argument solely based on his belief, rather than objectively pointing to the disclosure of Schenk or any other disclosure in the prior art, as required by law.

The Examiner, by thus failing to consider the term “including,” fails to present a *prima facie* case of obviousness, thereby impermissibly rejecting claim 8. Accordingly, Appellants respectfully request that the rejection of claim 8 be overturned.

(b) The Examiner impermissibly ignores the phrase “integrally formed therein” as recited in claim 8.

The Examiner seems to ignore the positively recited language of the phrases “integrally formed therein” with respect to reference to the first and second connecting members [26, 32] of claim 8. In the Final Office Action, as stated above in regards to the non-consideration of the term “including,” the Examiner limits his rejection to the statement: “[h]owever, Schenk discloses [sic] two pivot bearings [17] to couple the cover to the compartment body (figure 1, column 2 lines 60-65).” (Final Office Action mailed November 8, 2006 at page 5). Rather than specifying how each of the alleged first and second connectors [17] of Schenk are respectively integrally formed with the compartment body [11] and cover [16], the Examiner simply states that he “believes in a car, there are a first connecting member integrally formed in a compartment body and a second connecting member integrally formed in a cover, as a locking system, to open/close/retain the cover in closed position with the compartment body.” (Final Office Action mailed November 8, 2006 at page 5).

In other words, the Examiner impermissibly takes a two-step approach to arrive at the invention recited in claim 8. First, he construes the recited first and second connecting members of claim 8 as taking the form of the two bearings [17] in Schenk. Instead of specifying how each of the two alleged connecting members [17] is integrally formed respectively with the compartment body [11] and cover [16], he proceeds to a second step whereby he makes a statement of his own belief regarding two other unspecified connecting members defining a locking system in an unspecified car. (Final Office Action mailed November 8, 2006 at page 5). Simply stated, the Examiner

fails to consider the phrase “integrally formed therein” with respect to the connecting members [17] he construes in Schenk. He therefore impermissibly fails to consider all the terms recited in claim 8, as required by law.

The Examiner, by failing to consider the limitation provided by the phrase “integrally formed therein,” fails to present a *prima facie* case of obviousness, thereby impermissibly rejecting claim 8. Accordingly, Appellants respectfully request that the rejection of claim 8 be overturned.

VIII. Conclusion

In conclusion, Appellants respectfully request that the Board reverse the Examiner's rejections of all the pending claims and that the application be passed to issue. If there are any questions regarding the foregoing, please contact the undersigned at 513/241-2324. Moreover, this brief is being filed with a one-month extension fee. If any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

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APPENDIX OF CLAIMS

1. (Original) An automotive interior trim assembly, comprising:

a support; and

a storage compartment coupled to said support and adapted to store one or more items, said storage compartment comprising:

a compartment body defining a cavity adapted to store the one or more items and having an opening for gaining access to said cavity; and

a cover coupled to said compartment body and moveable between an open position, wherein said cavity is accessible through said opening, and a closed position, wherein said cover overlies said opening; and

an electroluminescent lamp molded to one of said compartment body and said cover and adapted to illuminate said cavity when said cover is in the open position.

2. (Original) The trim assembly of claim 1, wherein said electroluminescent lamp is molded to the compartment body.

3. (Original) The trim assembly of claim 1, wherein said electroluminescent lamp is molded to the cover.

4. (Original) The trim assembly of claim 1 further comprising:

an electrical circuit for energizing said electroluminescent lamp.

5. (Previously Presented) The trim assembly of claim 4, wherein said electrical circuit comprises:

a power source;

a first electrical connector rigidly coupled to said compartment body and electrically coupled to said electroluminescent lamp; and

a second electrical connector rigidly coupled to said support and electrically coupled to said power source, wherein said first electrical connector contacts said second electrical connector when said storage compartment is coupled to said support so as to energize said electroluminescent lamp.

6. (Original) The trim assembly of claim 4, further comprising:

an electrical switch having a first position that energizes the electroluminescent lamp and a second position that de-energizes the electroluminescent lamp.

7. (Original) The trim assembly of claim 6, wherein said electrical switch is in the first position when said cover is in the open position and said electrical switch is in the second position when said cover is in the closed position.

8. (Original) An automotive interior trim assembly, comprising:

a support; and

a storage compartment coupled to said support and adapted to store one or more items, said storage compartment comprising:

a compartment body defining a cavity adapted to store the one or more items and having an opening for gaining access to said cavity, said compartment body including a first connecting member integrally formed therein; and

a cover including a second connecting member integrally formed therein, said first connecting member cooperating with said second connecting member to couple said cover to said compartment body, said cover being moveable between an open position, wherein said cavity is accessible through said opening, and a closed position, wherein said cover overlies said opening; and

an electroluminescent lamp coupled to one of said compartment body and said cover and adapted to illuminate said cavity when said cover is in the open position.

9. Canceled

10. Canceled

11. Canceled

APPENDIX OF EVIDENCE

(None)

APPENDIX OF RELATED PROCEEDINGS

(None)